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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/925,186 | 08/09/2001 | Hitoshi Nara | 7217/65193 | 4224 |

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02/08/2005

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| EXAMINER |
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SCHUBERT, KEVIN R

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2137

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/925,186 | Applicant(s) NARA ET AL. | |
| | Examiner Kevin Schubert | Art Unit 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4 have been considered.

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each claim the applicant refers to the content data as being in "unreproducible form" which can be made usable by a key. Referring to the content as being in "unreproducible form" is a misnomer because the content is ultimately used in the system after a key is applied. The applicant should refer to the content as being in encrypted form or a form which is reproducible through a key, not as being in unreproducible form because the content is not unreproducible. Appropriate correction is required.

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Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

30

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kambayashi, U.S. Patent

As per claims 1 and 3, the applicant describes a content reproduction apparatus which comprises the following limitations which are met by Kambayashi:

a) a storage device for storing a plurality of content data encrypted not to be reproduced and an encryption key needed to decrypt said encrypted content data ([0441] and [0442]);

b) means for judging whether said content data is stored in said storage device in an unreproducible form when a medium which is capable of proving that a copyright fee is paid for said content data is inserted ([0466] and Fig 77);

c) means for making said content data judged to be stored in said unreproducible form reproducible by using said encryption key stored in said storage device ([0470]);

Kambayashi discloses an information reproduction apparatus with the same goal of the applicant's content reproduction apparatus. Both seek to "provide a digital information usage environment assuming protection by copyright" ([0005]).

One embodiment of Kambayashi's system meets the limitations of claim 1. In this embodiment, a device, such as a CD-ROM can be purchased from a store with content data and license information ([0441] and [0442]). When the device or medium is inserted into a computer, a decoding decision takes place as to whether the information on the device can be decoded ([0466]). This decision is based on the license information and may involve such checks as an expiration date check which uses a clock signal of the computer to determine whether the content data on the disc has expired.

If the decoding decision card (3001 of Fig 77) decides that decoding can take place, the information is decoded and placed into the information reproduction section (3004 of Fig 77) so that it can be reproduced.

Regarding part a), the storage device is the device, such as a CD-ROM, which can be bought at a store ([0441] and [0442]). The device can be inserted into a computer as seen in Fig 77. The information on the disc comprises content data and license information which contains a content key for decrypting the information on the disc ([0453] to [0461]) if it is deemed that the license has not expired.

Regarding part b), Fig 77 shows the removable storage medium (3002 of Fig 77) which is inserted into a computer system to prove that a copyright fee has been paid. The means for judging whether said content data is stored in an unreproducible form refers to means for judging whether the information is encrypted. Since the decoding decision card knows to extract the content key Kc (needed
5 to decrypt the contents info) it is inherent in the system that there is a mechanism for determining that the content data is encrypted. Paragraph [0468] gives more information on the process by which the decoding key sets up a session key between it and the information reproduction apparatus, extracts the content key Kc from the disc, and sends the content key to the information reproduction apparatus securely with the session key.

10 Regarding part c), the content information on the disc is decrypted by the content key Kc which is stored on the disc if it is deemed that the license information is valid.

Regarding claim 3, the only difference the claim has from claim 1 is that claim 3 discloses that the encryption key is stored on the medium which is inserted. This is met in regards to the discussion above in which the medium, or storage device, which is inserted has both the contents and the content key on it
15 ([0453] to [0461]).

As per claim 2, the applicant describes a content reproduction apparatus comprising the following limitations which are met by Kambayashi:

a) a storage device for storing a plurality of content data encrypted not to be reproduced and an
20 encryption key needed to decrypt said encrypted content data (Figs 1 and 3, [0199], [0209], [0219]);

b) means for acquiring an identifier of said content data requested to be reproduced via a communication line (Fig 26, [0287]);

c) means for executing a charging process needed to acquire said identifier ([0286], [0287];

d) means for judging whether said content data indicated by said identifier is stored in said
25 storage device in an unreproducible form (Fig 8, [0247]);

e) means for making said content data judged to be stored in said unreproducible form reproducible by using said encryption key stored in said storage device ([0239]);

Kambayashi describes another embodiment of his invention which anticipates claim 3. The gist of this embodiment is disclosed in paragraph [0008]. Kambayashi discloses an information reproduction apparatus similar to the applicant's content reproduction apparatus in which copyrighted content data is stored on an information storage section (9 of Fig 1). The copyrighted content is encrypted by a key, which Kambayashi refers to as the first decoding key in paragraph [0008]. The encrypted copyrighted content data and a section called the license information which contains the key (first decoding key) are encrypted by a second key which resides in another location of memory (6 of Fig 1). When information is to be reproduced, the system uses the second key to decode the license information. If it is determined that the license information is still valid, the first decoding key is extracted from the encrypted content data and license information and used to decrypt the content data for playback. If it is determined that the license information is not valid, which may be caused by an expiration data for example, an error is produced and the information is not reproduced.

Kambayashi's system is applicable to claim 2 because the license information can be updated through a communication line, such as a network (see Fig 26) in which a license information update server sends an encrypted update of the license information, which may be for example an extended expiration date, to the client. The client then stores the updated information in the information storage section.

Regarding part a), paragraph [0199] reiterates the discussion above about how Kambayashi's system discloses the idea of storing encrypted content data with the key to decrypting the data in a predetermined recording medium. The predetermined recording medium is the information storage section (Fig 1 and Fig 3) which can be a hard drive ([0209] and [0219]). The applicant should note that Fig 1 and Fig 3 represent the first and second embodiments of the invention which are virtually the same except for minor changes such as the placement of the information storage section.

Regarding part b), the identifier which is received over the communication line is the license information update. Fig 26 illustrates how the license information update server, upon receiving a confirmation of client payment signal from the electronic bank server, sends the license information update over the network to the client.

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Regarding part c), the charging process is disclosed in the paragraphs referenced above.

Regarding part d), the judging whether the content is in unreproducible form that the applicant refers to is determining whether the content is encrypted. As illustrated in Fig 8, data obtained from the information storage area is processed by a readout section (102 of Fig 8) and sent to a decoder unit (103 of Fig 8) for processing. It is inherent in the system that there is a mechanism for determining that the content is encrypted and needs to be sent to the decoder unit.

Regarding part e), the decoding key kd is the "second decoding key" discussed above which is previously stored and used to decrypt the content and license information stored on the information storage section. As discussed in paragraph [0237], the decoder unit which can be seen in Fig 26, is used to decode the license information and make a decision (which could be based on the expiration date) on whether to send the decoding key kd(1) or the "first decoding key" discussed above to the reproduction section to reproduce the content data. If the license information is valid, the accounting object information (or content data, see [0199]) is decoded.

Claims 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Braitberg, U.S. Patent No. 6,631,359.

As per claim 4, the applicant describes a content reproduction apparatus which comprises the following limitations:

a) a storage device for storing a plurality of content data encrypted not to be reproduced (Col 3, lines 18-27; Fig 6A);

b) means for acquiring an encryption key needed to decrypt said content data via a communication line (Col 11, lines 5-14; Col 19, lines 43-50);

c) means for executing a charging process needed to acquire said encryption key (Col 11, lines 1-7);

d) means for judging whether said content data corresponding to said encryption key is stored in said storage device in an unreproducible form (Col 10, lines 43-56);

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e) means for making said content data judged to be stored in said unreproducible form reproducible by using said acquired encryption key (Col 11, lines 11-14);

Braitberg describes a system aimed at protecting copyright data which meets the limitations of the applicant's above claim. In Braitberg's system, protected data on a disc can only be accessed
5 through a key which can only be obtained by paying a fee through a process such as an internet connection.

Fig 6A and 6B best illustrate the process. In Fig 6A a disc is inserted which has content data which could be protected (applicant's part a). A determination is made as to whether the disc has protected data in 614 (applicant's part d). If the disc does have protected data, the client connects to the
10 host at 624 and pays a fee at 640 for a key (applicant's part c). The key is then sent to the client at 644 (applicant's part b). The applicant is then allowed to play the content at 652 (applicant's part e). More description is given below.

Regarding part a), the storage device is the disc which contains the content data and may be encrypted. Only by obtaining a key, usually after paying a fee, can the client access the content (Col 3,
15 lines 18-27).

Regarding part b), once a fee has been paid, the host sends the client the decryption key. Some methods of communication through which the key can be obtained are discussed (Col 19, lines 43-50).

Regarding part c), the charging process is disclosed (Col 3, lines 18-27; Col 11, lines 1-7).

Regarding part d), a decision is made as to whether the data is encrypted and protected, in which
20 case a key is needed, or the data is not encrypted and thus able to be played.

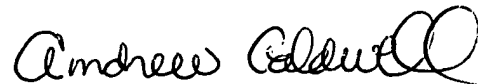
Regarding part e), once the key has been obtained, the content can be played by using the key to decrypt the encrypted contents (Col 11, lines 11-14).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
5 Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through
10 Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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